

Docket No.: SEIFARTH
Serial No.: 10/009,705

REMARKS

The last Office Action of September 22, 2005 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 10-25 are pending in the application. No claims were withdrawn. Claims 10, 15, 20 and 21 have been amended. Claims 12-14 have been canceled. Claim 26 has been added. A total of 14 claims is now on file. No claim surcharge is due. No amendment to the specification has been made.

Applicant hereby certifies that neither the international application nor the designation of the United States was withdrawn or considered to be withdrawn prior to the filing date of the U.S. national (35 U.S.C. 111(a)) application.

It is noted that claims 13-22 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is further noted that claims 12 and 14 are objected to.

Claims 13 and 15-22 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hermann et al, 1994 (cited in applicant's IDS of May 2002).

It is noted with appreciation that claims 10-11 and 23-25 are allowable over the prior art and that claim 14 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, second paragraph and to include all limitations of the base claims and any intervening claims.

It is further noted that the Sequence Listing is accepted.

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REJECTION OF CLAIMS 13-22 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Examiner stated that claim 13 is indefinite because allegedly there is no nexus between the preamble and the claim steps. The Examiner's rejection of claim 13 regarding the nexus between the preamble and the claims steps is confusing and not readily understood, and no specifics have been stated the Examiner considers lacking.

Claim 13 has now been cancelled. The subject matter of claim 14 (dependent on claim 13), which the Examiner considered allowable if rewritten to overcome the rejection under §112, is now presented as new claim 26. Claim 26 has been drafted to include the term —identifying—, the lack of which applicant understood to be the grounds for the Examiner's rejection for lack of nexus. It is applicant's position that former claim 14 adequately set forth steps that provide a nexus between the method steps and the preamble. Should the Examiner maintain the rejection in a subsequent Office action, applicant respectfully requests that such rejection be non-final, to allow for clarification by the Examiner and an opportunity for applicant to respond.

With regard to claims 15 and 20, the Examiner has found confusing applicant's phrase*between one of*...in claims 15 and 20 and proposed the same language analog claims 16 and 21. In response to the Examiner's request, applicant has deleted the phrase ...*one of*...so that the rejection thereof is now obviated.

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The Examiner's rejection of claim 21 has been eliminated by deleting the offensive dependency to claim 3-6. Claim 21 has been amended to now depend from claim 26.

As a result of the cancellation of claim 13, the rejection under 35 U.S.C. §112, second paragraph becomes moot.

Withdrawal of the rejection of the claim 13-22 under 35 U.S.C. §112, second paragraph is thus respectfully requested.

CLAIM OBJECTIONS AND CLARIFICATION AMENDMENT

Claims 12-14 have been cancelled thereby obviating the Examiner's objection.

Claims 10 and 16 were amended to correct obviously typographical errors.

REJECTION OF CLAIMS 13, 15-22 UNDER 35 U.S.C. §102(b) AS BEING ANTICIPATED BY HERMANN (1914)

The rejection under 35 U.S.C. 102(b) is respectfully traversed.

Claim 13 has been cancelled. The Examiner has indicated allowability of claim 14 if rewritten in independent form if the rejections under 35 U.S.C. §112, second paragraph are obviated. In view of the Examiner's grounds for rejection, applicant canceled original claims 13 and 14 in favor of new claim 26, which has been rewritten to include those limitations of originally filed claim 14. Accordingly, applicant asserts that claim 26 has not been narrowed to trigger prosecution

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history estoppel. *See Salazar v. Procter & Gamble Co.*, 75 USPQ2d, 1369 (stating that introducing claim 7 based on the allowable subject matter of dependent claim 3 of the "149 application was not a narrowing amendment for purposes of patentability and, therefore, does not by itself give rise to prosecution history estoppel). Applicant has inserted the term –identifying– after the word “detecting” since the Examiner has alleged lack of nexus. Applicant asserts that addition of the term –identifying–does not narrow the claim for purposes of patentability. As it now is presented, claim 26 is believed to patentably distinguish over the prior art of record and satisfies the requirement of 35 U.S.C. §112, second paragraph.

Since claim 13 has been cancelled and claims 15-22 are either directly or indirectly dependent on claim 26 the subject matter of which was indicated allowable; therefore these claims are also allowable.

Withdrawal of the rejection of claims 13, 15-22 under 35 U.S.C. §102(b) is thus respectfully requested.

CITED REFERENCES

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the newly submitted claim. It is thus felt that no specific discussion thereof is necessary.

It is noted that the Examiner has considered the references as submitted with the Information Disclosure Statement and indicated this in the former Office Action of May 31, 2005.

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CONCLUSION

Applicant believes that when reconsidering the claims in the light of the above comments, the Examiner will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

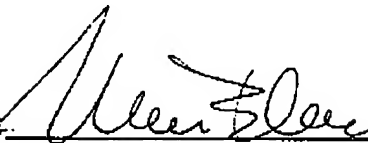
In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

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Respectfully submitted,

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